REMARKS

In the Final Office Action[1], the Examiner rejected claims 1-9, 12-14, and 16-17 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,012,088 to Li et al. ("*Li*") in view of U.S. Patent No. 6,130,892 to Short et al. ("*Short*"); rejected claims 10 and 14 under 35 U.S.C. § 103(a) as unpatentable over *Li* and *Short* in view of U.S. Patent No. Application Publication No. 2002/0032782 to Rangan et al ("*Rangan*"); and rejected claims 11 and 15 under 35 U.S.C. § 103(a) as unpatentable over *Li* and *Short* in view of U.S. Patent No. 5,623,637 to Jones et al. ("*Jones*").

Applicants respectfully traverse the rejection of claims 1-9, 12-14, and 16-17 under 35 U.S.C. § 103(a).

As a preliminary matter, in the Final Office Action mailed August 21, 2006 ("the Final Office Action"), the Examiner repeats the rejection of claims 1-9 under 35 U.S.C. § 103(a) as unpatentable over *Li* in view of *Short* from the Office Action mailed March 30, 2006 ("the Office Action") (See pg. 3 of Office Action, pg. 2 of Final Office Action). In a Reply to Office Action dated June 23, 2006, ("the Reply") Applicants pointed out several deficiencies in the Office Action, noting that both *Li* and *Short* fail to teach or suggest a storage medium with connection setup information "stor[ed] by the Internet service provider" as recited by claim 1.

However, the Examiner has not responded to this reasoning. Instead, the Examiner indicates, in a "Response to Arguments" section, that Applicants' arguments

[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

are moot in view of the "new ground(s) of rejection" (Final Office Action at p. 2). The Examiner then simply repeats the assertion that "the *Li* reference teaches ... storing by the Internet service provider, the connection setup information in a storage medium" (Office Action at p. 3, Final Office Action at p. 2). This failure to address Applicants' reasoning is improper. M.P.E.P. 707.07(f) indicates that "[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

Because the Examiner failed to properly address Applicants' traversal of the 35 U.S.C. § 103(a) rejection, Applicants request withdrawal of the finality of the last Office Action. If the Examiner continues to dispute the patentability of the pending claims, Applicants request a new non-final Office Action, including a complete response to all of Applicants' arguments, as this will clarify the Examiner's position.

The Examiner has also improperly relied on Official Notice in the Final Office Action in rejecting claim 1, stating, "'transferring data on a storage medium and a client locally installing the storage medium' in a computer networking environment was well known in the art at the time the invention was made" (Final Office Action at p. 2). Claim 1 actually recites "transferring the storage medium from the internet service provider to the client" (emphasis added).

Moreover, M.P.E.P 2144.03(A) indicates, "[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known," and continues, "[i]f applicant

adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next office action."

The Examiner has not provided any such documentary evidence in the Final Office Action. Instead, the Examiner selectively cites to *In re Boon*, 169 U.S.P.Q. 231, 234 (C.C.P.A. 1971). The cited paragraph of *In re Boon* states, in full:

> Ordinarily, citation by the board of a new reference, such as the dictionary in this case, and reliance thereon to support a rejection, will be considered as tantamount to the assertion of a new ground of rejection. Compare In re Ahlert, supra. This will not be the case, however, where such a reference is a standard work, cited only to support a fact judicially noticed and, as here, the fact so noticed plays a minor role, serving only "to 'fill in the gaps' which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection." Ibid. Under such circumstances, as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed to warrant reopening of the prosecution so that the applicant could respond. Clearly, such a rule would effectively destroy any incentive on the part of the board to clarify or justify a position taken by an examiner through the artful use of facts judicially noticed. We feel it to be perfectly consistent with the principles governing procedural due process to require that a challenge to judicial notice by the board contain adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying the judicial notice. Appellant's correspondence before the Board of Appeals following its decision in this case, is not even reproduced in the record before us. We therefore have no basis to conclude anything other than that there could not have been a proper challenge.

(emphasis added). Thus, the Examiner in *In re Boon* had already provided a reference, i.e., the dictionary, to support the taking of Official Notice. Therefore, *In re Boon* does not excuse the Examiner's complete failure to support the alleged Official Notice.

In addition to the rejection of claim 1, the Examiner has improperly relied on official notice to support the rejection of independent claims 4, 5, and 9. Applicants

respectfully request that the Examiner either provide documentary evidence to support the taking of official notice, or withdraw the rejection.

Further, the cited references and official notice, taken alone or in combination, fail to teach or suggest each and every element of the claims. Claim 1, for example, recites a method of setting up an Internet server, wherein a "connection setting processing procedure ... updates the connection setup information stored on the locally installed storage medium in accordance with the current connection setup information stored on the server." The cited references and official notice fail to teach or suggest at least the claimed connection setting processing procedure.

The Examiner concedes that *Li* does not teach this subject matter, and does not take official notice of the claimed "updat[ing] the connection setup information stored on the locally installed storage medium in accordance with the current connection setup information stored on the server" (Final Office Action at p. 3). However, the Examiner alleges that *Short* teaches this subject matter (Final Office Action at p. 3).

Short discloses a "'[n]omadic' translator or router 10 ... connected between a host device or computer 12 and a communications device 14. The host device 12 is a laptop computer or other ... terminal" (*Short* col. 5, lines 32-36). *Short* continues, "the present router 10 is essentially a translator which enables the host device 12 to be automatically and transparently connected to any communications device 14" (*Short* col. 5 line 67 to col. 6 line 3). The Examiner's position is apparently that the router in *Short* corresponds to the claimed storage medium, as the Examiner cites portions of *Short* disclosing that the router can be embodied as a "digital storage medium," and that the

computer in *Short* corresponds to the claimed server (Office Action at p. 3, *Short* col. 9 lines 39-40).

However, the router in *Short* does not update its own connection setup information in accordance with connection setup information stored on the computer. Instead, *Short* discloses 3 different methods for "redirect[ing] all outbound packets from the host computer to itself" (*Short* col. 11, lines 53-54). The first such method is "Proxy ARP Packet Interception and Host Reconfiguration," where "the nomadic router 10 receives [the] ARP request broadcast and responds with its MAC address (not that of the destination node)" (emphasis added) (*Short* col. 11, lines 57-63). Thus, even assuming the MAC address corresponds to the claimed "connection setup information," as described the router in *Short* uses its own MAC address, and not that of the computer. Thus, the "Proxy ARP" method of *Short* does not teach or suggest the claimed "updat[ing] the connection setup information stored on the locally installed storage medium in accordance with the current connection setup information stored on the server."

The second method disclosed in *Short* for redirecting packets is "Promiscuous Mode Packet Interception," where the "network connection on the nomadic router accepts all packets being transmitted on the communication link, not just ones being broadcasted or addressed specifically to it" (*Short* col. 12, lines 14-30). However, *Short* does not disclose that connection setup information for the "Promiscuous Mode" is updated in accordance with any connection setup information on the computer. Thus, the "Promiscuous Mode" method of *Short* does not teach or suggest the claimed "updat[ing] the connection setup information stored on the locally installed storage

medium in accordance with the current connection setup information stored on the server."

The final method disclosed in *Short* for redirecting packets is "Dynamic Host Configuration Protocol (DHCP) Service," where "the nomadic router 10 will intercept these [DHCP] requests and respond with configuration information for the host computer 12 to use" (*Short* col. 12, lines 31-39). At best, this amounts to a teaching that the connection setup information on the computer is updated in accordance with connection setup information on the router, not the router updated according to information on the computer. Thus, the "DHCP" method of *Short* does not teach or suggest the claimed "updat[ing] the connection setup information stored on the locally installed storage medium in accordance with the current connection setup information stored on the server."

Although of different scope, independent claims 4, 5, and 9 recite subject matter similar to claim 1. Claims 2, 3, 8, 12, and 13 depend from claim 1, claims 14, 16, and 17 depend from claim 4, and claims 6 and 7 depend from claim 5. As already discussed, none of the cited references teach or suggest the claimed "updat[ing] the connection setup information stored on the locally installed storage medium in accordance with the current connection setup information stored on the server."

Because the cited references fail to teach or suggest each and every claim element recited by claims 1-9, 12-14, and 16-17, no prima facie case of obviousness has been established. Applicants therefore request the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

Applicants respectfully traverse the rejection of claims 10 and 14 under 35 U.S.C. § 103(a). Claim 10 depends from claim 1, and claim 14 depends from claim 4, and therefore require all of the elements recited therein. As already discussed, *Li* and *Short* fail to teach or suggest the claimed "updat[ing] the connection setup information stored on the locally installed storage medium in accordance with the current connection setup information stored on the server."

Rangan fails to cure the deficiencies of *Li* and *Short*. *Rangan* discloses, "a unique Internet portal is provided and adapted to provide unique services to users who have obtained access via an Internet or other network connection from an Internet-capable appliance" (*Rangan* ¶ 20). However, *Rangan* does not disclose updating connection setup information for any device in accordance with connection setup information stored on the Internet-capable appliance or another device. Therefore, *Rangan* fails to teach or suggest the claimed "updat[ing] the connection setup information stored on the locally installed storage medium in accordance with the current connection setup information stored on the server."

Because the cited references fail to teach or suggest each and every claim element recited by claims 10 and 14, no *prima facie* case of obviousness has been established with respect to these claims. Applicants therefore respectfully request the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

Applicants respectfully traverse the rejection of claims 11 and 15 under 35 U.S.C. § 103(a). Claim 11 depends from claim 1, and claim 15 depends from claim 4, and therefore require all of the elements recited therein. As already discussed, *Li* and *Short* fail to teach or suggest the claimed "updat[ing] the connection setup information stored

on the locally installed storage medium in accordance with the current connection setup information stored on the server."

Jones fails to cure the deficiencies of *Li* and *Short*. *Jones* discloses, "a detachable PCMCIA memory card incorporating a smart-card integrated circuit for storing a password value and logic circuitry for preventing access to information stored on the memory card unless the user of the host computer to which the memory card is connected can supply a password matching the stored password." However, *Jones* does not disclose updating connection setup information for the memory card or in accordance with connection setup information stored on the memory card. Therefore, *Jones* fails to teach or suggest the claimed "updat[ing] the connection setup information stored on the locally installed storage medium in accordance with the current connection setup information stored on the server."

Because the cited references fail to teach or suggest each and every claim element recited by claims 11 and 15, no *prima facie* case of obviousness has been established with respect to these claims. Applicants therefore respectfully request the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

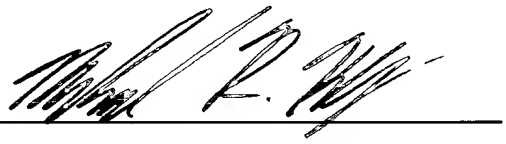
In view of the foregoing remarks, Applicants respectfully request reconsideration of the application and withdrawal of the rejections. Pending claims 1-17 are in condition for allowance, and Applicants request a favorable action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: September 28, 2006

By: 

Michael R. Kelly
Reg. No. 33,921